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REMARKS

Claims 1-2, 5-11 and 14-17 were pending in the subject application. By this Amendment, applicant has amended claim 1. Support for the amendments to claim 1 may be found in the specification, *inter alia* at page 2, lines 22-33, at page 3, lines 2-7 and at page 5, lines 13-18 as well as figures 7-8.

No issue of new matter is raised by these amendments. Accordingly, upon entry of this Amendment, claims 1-2, 5-11 and 14-17, as amended, will be pending and under examination in the subject application.

Claim 1 has been amended for clarity and to recite that the hygienic means comprises one, single, uniform, substantially U-shaped rip tag (7) extending over the top of the front side of the tip of the sheath (1)...

In view of the amendments to claim 1 and the remarks which follow, applicant maintains that the grounds of rejection set forth in the August 28, 2009 Office Action have been overcome, and respectfully requests that the Examiner reconsider and withdraw the grounds of rejection set forth in the August 28, 2009 Office Action.

Rejections Under 35 U.S.C. § 103

- A. The Examiner rejected claims 1-2, 5-8 and 14-17 under 35 U.S.C. §103(a) as allegedly unpatentable over Berg (US Patent No. 4,863,448).

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On page 3 of the Office Action, the Examiner stated that Berg discloses all aspects of the claimed invention with the exception of the rip tag comprising a single piece of material. The Examiner stated that the rip tag encircles the outer surface of the sheath, as shown in Figure 13, and therefore extends around the front side of the sheath. The Examiner also stated that forming the rip tag out of a single piece of material, rather than the two connected pieces shown by Berg in figure 14, would provide the predictable result of simplifying the process of manufacturing the sheath, since it would reduce the number of steps to form the rip tag. The Examiner further stated that it would be obvious to one of ordinary skill in the art at the time of invention to form the rip tag of Berg from a single piece of material to provide the predictable result of simplifying the process of manufacturing.

Berg discloses that the ring 50 encircles the outer surface of the sheath by going around the front side of the sheath. However, applicant notes that the ring 50 of Berg does not go over the top of the front side of the tip of the sheath as recited in amended claim 1. The rip tag of Berg is described inter alia at column 3, lines 63-67 and shown in Figures 11 and 14 to be comprised of two similar joined halves that are not U-shaped and do not extend over the top of the front side of the tip of the sheath.

Applicant contends that from figures 11-14 of Berg, the ring (50) must be made of a rigid or semi-rigid material in order to be opened by compressing it from the sides. Applicant notes that the ring will be left on the shaft of the penis,

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torn apart with two hands or slipped back down off the penis as described inter alia at column 4, lines 6-9. Applicant contends that the rigid or semi-rigid ring could not possibly operate in the same manner as the rip tag of applicant's invention which can be positioned very easily with just one hand without leaving the rip tag on the penis.

Applicant contends that if the rip tag of Berg were modified to form a single continuous piece, there would be two possibilities.

On the one hand, the structure would be continuous, annular and outside applicant's claimed invention.

On the other hand, if the rip tag of Berg were modified so that it would be U-shaped it would be rigid or at least semi-rigid. Applicant contends that so modified, the rip tag of Berg would circle the shaft of the penis in a horizontal plane if such a modified U-shaped rigid or semi-rigid rip tag were positioned in a similar way to that shown in Figures 11-14. In contrast, the rip tag of applicant's claimed invention circles the shaft of the penis in a vertical plane. Applicant contends that the rip tag of Berg so modified would be perpendicular to the shaft of the penis, whereas the rip tag of applicant's claimed invention is parallel to the shaft of the penis.

Applicant also contends that the rip tag of Berg so modified would have impaired structure and function compared to the rip tag of applicant's claimed invention since it would not be possible to remove the modified rip tag with one hand.

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Applicant refers to Figure 14 which shows that the rip tag of Berg is intended to be removed with two hands. Applicant contends that the rip tag of Berg is not removable by one hand movement as is applicant's claimed hygienic means.

Applicant further contends that modifying the rip tag of Berg by forming it from one single piece would lead to a rip tag with predictable, poorer properties and structure than the rip tag of applicant's claimed invention.

Finally, applicant contends that Berg does not disclose or render obvious the following element recited in amended claim 1: one, single, uniform, substantially U-shaped rip tag extending over the top of the front side of the tip of the sheath.

In view of the preceding remarks and the amendments to claim 1 applicant requests that the Examiner reconsider and withdraw the rejection under 35 U.S.C. §103(a).

B. The Examiner rejected claim 9 under 35 U.S.C. §103(a) as allegedly unpatentable over Berg (US Patent No. 4,863,448) in view of Figuerido (US Patent No. 5,643,235).

As indicated above, Berg does not disclose the following element: one, single, uniform, substantially U-shaped rip tag extending over the top of the front side of the tip of the sheath. This element is recited in amended claim 1 from which claim 9 depends.

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Figuerido also does not disclose this element, namely, one, single, uniform, substantially U-shaped rip tag extending over the top of the front side of the tip of the sheath. Therefore, no combination of Berg and Figuerido contains all the elements of amended claim 1. Accordingly, the subject matter of claim 9 which depends from amended claim 1 cannot be obvious to a person of ordinary skill from a combination of the teachings of Berg and Figuerido.

In view of the foregoing remarks applicant requests that the Examiner reconsider and withdraw this ground of rejection under 35 U.S.C. §103(a).

C. The Examiner also rejected claims 10 and 11 under 35 U.S.C. §103(a) as allegedly unpatentable over Berg (US Patent No. 4,863,448) in view of Smith (US Patent No. 4,601,716).

As indicated above, Berg does not disclose the following element: one, single, uniform, substantially U-shaped rip tag extending over the top of the front side of the tip of the sheath. This element is recited in amended claim 1 from which claims 10 and 11 depend directly or indirectly.

Smith also does not disclose this element, namely, one, single, uniform, substantially U-shaped rip tag extending over the top of the front side of tip of the sheath. Therefore, no combination of Berg and Smith contains all the elements of amended claim 1. Accordingly, claims 10 and 11 cannot be obvious from a combination of the teachings of Berg and Smith.

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In view of the foregoing remarks applicant requests that the Examiner reconsider and withdraw this ground of rejection under 35 U.S.C. §103(a).

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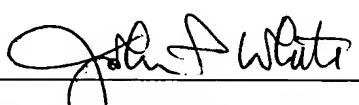
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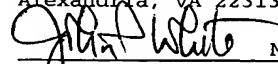
A sincere effort has been made to present claims which clearly and patentably distinguish over the cited art. In view of the preceding amendments and remarks, the Examiner is urged to withdraw the rejections of the claims and to pass the application to allowance.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,


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